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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,053	09/07/1999	JEFFREY A. ROBL	LA24A	8000

23914 7590 06/17/2002

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EXAMINER

BAHAR, MOJDEH

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/17/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/391,053
Filing Date: September 07, 1999
Appellant(s): ROBL ET AL.

Ronald S. Hermenau
For Appellant

EXAMINER'S ANSWER

MAILED

JUN 17 2002

GROUP 2900

This is in response to the appeal brief filed March 14, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest, Bristol-Myers Squibb Company, is contained in the brief.

(2) *Related Appeals and Interferences*

A statement indicating that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Whether the instant invention is obvious over Hotamisligil in view of appellants' admission on page 4, lines 2-7 of the specification.

(7) *Grouping of Claims*

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Appellant's brief includes a statement that claims do stand or fall together, but provides no reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Hotamisligi et al. "Uncoupling of Obesity from Insulin Resistance through a Targeted Mutation of aP2, the Adipocyte Fatty Acid Binding Protein", Science, Vol. 274, (Nov 22, 1996), pp. 1377-79.

Appellants's admissions on page 4, lines 2-7 of the specification.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 5-11 and 14-15 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 15. This rejection is reproduced herein below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-11 and 14-15 in part are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotamisligil et al. in view of *Failli et al. (USPN 5,218,124) as disclosed in the specification beginning at the top of page 4.* This rejection is of record in the prior office action.

Hotamisligil et al. teaches that aP2 deficient mice do not develop diabetes, see abstract.

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Hotamisligil et al. does not teach that the elected oxazole compound specie is an aP2 inhibitor.

Failli et al. (USPN 5,218,124) teaches that oxazole derivative compounds including the elected compound herein are known aP2 inhibitors.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the elected oxazole derivative compound herein in a method for the treatment of diabetes.

One of ordinary skill in the art would have been motivated to employ this oxazole compound in a method of treating diabetes since it is a known aP2 inhibitor. Therefore, it would be reasonably expected to be therapeutically useful in the treatment of diabetes similar to any other compound which reduces or antagonizes aP2 activity.

(11) Response to Argument

Appellants argue that the Examiner has improperly used appellants' own admissions on page 4, lines 2-7 of the specification as a secondary reference in the obviousness rejection under 35 USC 103. Note that in the first office action, the examiner has referred to Failli et al. (USPN 5,218,124) as disclosed in the specification beginning at the top of page 4. The examiner has cited to nothing more than the appellants' admissions regarding the prior art. On page 4 of the specification appellants admits that:

"Examples of aP2 inhibitors suitable for use herein include compounds which include an oxazole or analogous ring. Thus, U.S. Patent No. 5,218,124 to Failli et al. (the disclosure of which is incorporated herein by reference) discloses compounds which have activity as aP2 inhibitors and thus suitable for use herein...."

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When appellants state that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975). *In re Hellsund*, 177 USPQ 170, held that statement made by appellants, whether in patent application or in other papers submitted during prosecution, that certain matter is prior art to him, is an admission that that matter is prior art for all purposes, whether or not a basis in 35 U.S.C. 102 can be found for its use as prior art.

Appellants further argue that the Examiner “has manufactured” this admission since the appellants have merely described their own invention. Note that the specification in relevant part provides:

Failli et al. (the disclosure of which is incorporated herein by reference) **discloses compounds which have activity as aP2 inhibitors and thus suitable for use herein....**

Appellants’ position is thus not supported by the specification since they have clearly stated that “Failli et al. discloses...”.

The claimed methods are considered obvious over the cited prior art, absent evidence to the contrary. No such evidence is seen.

For the above reasons, it is believed that the rejections should be sustained.

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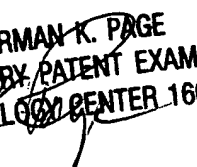
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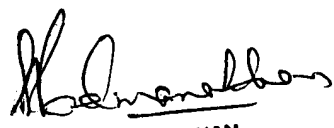
Mojdeh Bahar, J.D.
June 3, 2002

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